

## **REMARKS**

### **I. Status of the Application**

Claims 1-13 are pending in the application. In a Non-Final Office Action dated November 7, 2005 the Examiner:

1. Acknowledged response by Applicants representative received on August 11, 2005 and the election of claims 1-13 without traverse and the withdrawal of claims 14-29;
2. Rejected claims 1, 11, 12 under 35 USC § 102(b) as being anticipated by Bernstein et al, U.S. Patent No. 6,497,410 ("Bernstein");
3. Rejected claims 2-10 and 13 under 35 USC § 103(a) as being unpatentable over Bernstein.

In this Response, Applicants traverse the examiner's rejection of claims 1, 11, and 12 under 35 USC § 102(b). Applicants also traverse the examiner's rejections of claims 2-10 and 13 under 35 USC § 103(a). Accordingly, claims 1-13 remain pending in the present application. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

### **II. Rejection of Claims 1, 11 and 12 under 35 USC § 102(b) should be withdrawn because Bernstein does not disclose each element of Applicants' invention.**

In the Office Action the examiner rejected claims 1, 11 and 12 under 35 USC § 102(b) as being anticipated by Bernstein. A rejection under 35 USC § 102(b) can be overcome by "persuasively arguing that the claims are patentably distinguishable from the prior art." MPEP § 706.02(b). Applicants' respectively submit that rejection of claims 1, 11, and 12 should be

withdrawn because Bernstein does not teach (expressly or inherently) all the limitations of any of these claims as would be required by MPEP § 2131 to support an anticipation rejection. Applicants' claim 1 is an independent claim. Claims 11 and 12 depend ultimately from independent claim 1. At a minimum, Bernstein fails to teach a "customer loyalty indicator," which is an element of Applicants' invention as claimed in claim 1.

A prior art patent, publication, or event is for the same "invention," as that word is used in the 35 USC § 102, and therefore anticipated, if the prior art patent, publication or event discloses each and every limitation found in the claims, either expressly or inherently. *Lockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Each claim limitation must be found in a single prior art reference; references cannot be combined under 35 USC § 102. *Apple Computer, Inc. v. Articulate Systems, Inc.* 234 F.3d 14,20 (Fed. Cir. 2000); *Kalman v. Kimberly-Clark Corp.* 713 F.2d 760 (Fed. Cir. 1983). "[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131.01. Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on 35 USC § 102. *Connell v. Sears, Robuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

The examiner alleges that Bernstein discloses each element of Applicants' invention. More specifically, the examiner alleges that Bernstein discloses the customer loyalty indicator of Applicants' invention in that Bernstein discloses "stock performance information." Applicant, however, respectfully submits that Bernstein does not disclose the customer loyalty indicator as required to practice Applicants' invention.

The "stock performance" information of Bernstein is not the same as or equivalent to the "customer loyalty indicator" of Applicants' invention. With respect to the "customer loyalty indicator," Applicants' specification states, *inter alia*. Applicants' "customer loyalty indicator" is an element related to the likelihood that a customer of a company will continue to do business with the company.

...the fifth area 20 denotes the loyalty of the customer represent by playing card 15 to the game player's company. In the present embodiment, customer loyalty is represented by one of four distinct colors. Of course, more or fewer colors may be added to indicate varying levels of loyalty. Also, it is understood that symbols may be used to indicate the various levels of loyalty instead of color, and that color may optionally represent another type of customer information. In this illustrated embodiment, a green color in the fifth area 20 indicates that the customer is very loyal (truly loyal customer), a yellow color in the fifth area 20 indicates that the customer is loyal in attitude but does not intend to repurchase (accessible customer), a blue color in the fifth area 20 indicates that the customer is not loyal, but can not leave the relationship (trapped customer), and a red color in the fifth area 20 indicates that the customer is not loyal, and is likely to leave (high risk customer). Published Application, ¶ 0036.<sup>1</sup>

The "share price" information of Bernstein is not the same or equivalent to the "customer loyalty indicator" of Applicants' invention. In fact, the share price information of Bernstein has absolutely nothing to do with customer loyalty and Bernstein in general has nothing to do with customer loyalty specifically and customer information usage generally. Rather, Bernstein is a trading card game that teaches fundamental investment skills and strategies to build an investment portfolio based on actual corporate business entities and actual stock market conditions. Bernstein Col. 3, Ins. 18-22. The price information of Bernstein is an issue price

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<sup>1</sup> Applicants' cites to the specification are to the specification as published in Published Application No. US 2005/0218595 A1 published on October 6, 2005.

represented by a numerical value of one share of stock in the corporate business limits entity associated with each card 10 on the issue date of the card 10 which equals the actual price of an actual share of stock. *Id.* Col. 4, lns. 22-26. The stock performance information may also include, in addition to stock prices, chart/graphs of stock prices, P/E ratio and earnings per share. *Id.* Col. 4, lns. 30-37. In its broadest sense, the stock performance information of Bernstein is information reflecting the value of a company's common stock.

In contrast, the customer loyalty indicator of Applicants' invention, is an indicator of the likelihood that a customer is going to continue to do business with a company. The value of a company's common stock (i.e. stock price) has no relevance or relationship to the loyalty a company's customer may have to it and whether or not that customer will continue to do business with the company. Consequently, Applicants respectfully submit that the "customer loyalty indicator" of Applicants' invention is not shown, either explicitly or implicitly, in Bernstein. Because Bernstein does not disclose each element of Applicants' invention, Applicants respectfully submit that the rejection of claim 1 under 35 USC § 102(b) should be withdrawn. Moreover, because claims 11 and 12 ultimately depend from allowable base claim 1, claims 11 and 12 are also allowable. MPEP § 608.01(n).

**III. The rejection of claims 2-10 and 13 under 35 USC § 103(a) as being unpatentable over Bernstein should be withdrawn.**

In the Office Action, the examiner rejected claims 2-10, and 13 under 35 USC § 103(a) as being unpatentable over Bernstein. Applicants respectfully submit that rejection of claims 2-10 and 13 are overcome and should be withdrawn because claims 2-10 and 13 depend from and include all of the limitation of allowable claim 1. A dependent claim that depends from an

allowable base claim is also allowable. MPEP § 608.01(n). Moreover, if an independent claim is not obvious under 35 USC § 103, then any claim depending there from is not obvious. MPEP § 2143.03(citing *In Re Fine* 837 F.2d. 1382,1385(CCPA 1970)). As Applicants have shown that Bernstein does not anticipate Applicants' claim 1. Further, claim 1 is not obvious in view of Bernstein. Therefore, claims 2-10 and 13, which all depend from claim 1, are also allowable subject matter. Accordingly, Applicants respectfully request that the examiner's rejection of claims 2-10 and 13 under 35 USC § 103(a) be withdrawn and that claims 2-10 and 13 proceed to allowance.

Moreover, Applicants respectfully submit that the rejections of claims 2-10 and 13 under 35 USC § 103(a) should be withdrawn on the further bases that Bernstein is nonanalogous art. MPEP § 2141.01(a) provides that under § 103 "an examiner must determine what is analogous prior art to determine the obviousness of the invention at issue. In order to rely on a reference under § 103(a) as a basis for rejection of Applicants' invention, the reference must either (i) be in the field of Applicants' endeavor or, if not, then (ii) be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a)(quoting *In Re Oetiker*, 977 F.2d 1443, 1447(Fed. Cir. 1992)).

First, Bernstein is not within the field of Applicants' invention. Bernstein is directed to the field of collectible trading cards which feature information related to a corporate business entity and an investment game using the collectible trading cards which is designed to raise awareness in the concepts of investing in the stock market. Bernstein, Col. 1, lns. 10-14; 65-67; Col. 2, lns. 1-7.

In contrast, Applicants' invention relates to customer relationship and management skills development and more particularly in understanding how to combine, coordinate and use the information a company has about its customers to foster the relationship between a company and its customers. Published Application ¶¶ 0001, 0003. Consequently, Bernstein is not in the field of Applicants' endeavor.

Second, Bernstein is not reasonably pertinent to the particular problem that Applicants address with their invention. The purposes for both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure is directed to a different purpose, the inventor will have little motivation or occasion to consider it. *In Re Oetiker*, 977 F 2d. 1447.

Applicants' invention is concerned with the challenge facing many companies involving how to combine and coordinate the information a company may have about its customers. Many key employees of these companies lack skills on how to value different types of customer information. The present invention is also concerned with training company employees to understand the value of customer information, including customer loyalty because an employee who understands the importance of using such information is better equipped to make good business decisions and to teach employees to focus on certain customer information and to consider decision making using the customer information. Published Application, ¶¶ 0001, 0003.

Conversely, Bernstein is directed to a very different purpose. As previously discussed, Bernstein is directed to collectible trading cards which are designed to raise awareness in the concepts of investing in the stock market. Consequently, no motivation exists for one skilled in

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the art of customer relationship, information, and management of that information to even consider Bernstein when considering the problems solved by the present invention.

Because Bernstein is "not within the field of the inventors' endeavor" and (ii) is "not reasonably pertinent to the particular problem that the present invention solves," Bernstein is nonanalogous art. Therefore, Bernstein cannot serve as a basis for an obviousness type rejection. MPEP § 2141.01(a). Consequently, Applicants respectfully submit that the rejection of claims 2-10 and 13 under 35 USC § 103(a) should be withdrawn for the additional reason that the rejection of said claims was improperly based upon nonanalogous art.

### **CONCLUSION**

For all the foregoing reasons, it is respectfully submitted that the Applicants have made a patentable contribution to the art and that this response places the above identified application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested.

Applicants respectfully petition for a one month extension of time within which to respond to the November 7, 2005 Office Action. A check in the amount of \$60.00 is enclosed, which is the fee for the one month extension of time.

In the event that Applicants have inadvertently overlooked the need for payment of an additional fee, Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 09-0007.

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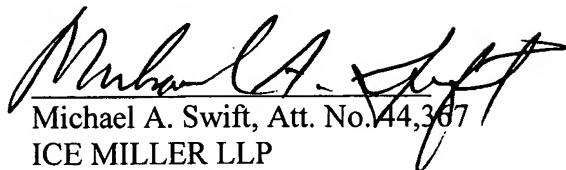
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Respectfully submitted,  
ICE MILLER LLP

A handwritten signature in black ink, appearing to read "Michael A. Swift", is written over a horizontal line.

Michael A. Swift, Att. No. 44,367

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Check in the amount of \$60.00

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